



Application no. 10/823,099

August 15, 2005

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attn: Art Unit 2814 - Examiner Le, Thao X

FROM: George O. Saile, Reg. No. 19,572
28 Davis Avenue
Poughkeepsie, N.Y. 12603

SUBJECT: Serial #: 10/823,099
File Date: 04/13/2004
Inventor: Thomas Aisenbrey
Examiner: Le, Thao X
Art Unit: 2814
Title: Low Cost Chip Carrier with Integrated Antenna, Heat Sink, or
EMI Shielding Functions Manufactured from Conductive
Loaded Resin-Based Materials

RESPONSE TO RESTRICTION REQUIREMENT

Dear Sir:

This is in response to the Restriction Requirement in the Office Action dated July 14, 2005. In that office action, restriction was required to one of the following Inventions under

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents P.O. Box 1450, Alexandria, VA 22313-1450 on Aug. 15, 2005.

Signature 
Stephen B. Ackerman, Reg. No. 37,761

Date: Aug. 15, 2005

35 U.S.C. 121:

The inventions stated are:

I - Claims 161, drawn to a semiconductor device, classified in class 257, subclass 723-726, and

II - Claims 61-72, drawn to a method of making a semiconductor device, classified in class 438, subclass 107, 109-100 and 117.

Applicant believes the Claim identified in Group I is a typographical error, and that the Examiner intended to identify Claims 1-61 as Group I (especially in light of the subsequent species requirement). The response below will be based on this.

Applicant provisionally elects to be examined the Invention described by the Examiner as Group I - Claims 1-61, drawn to a process classified in Class 257, subclass 723-726. This election is made with traverse of the requirement under 37 C.F.R. 1.143 for the reasons given in the following paragraphs.

The Examiner is respectfully requested to reconsider the Requirement for Restriction in the Office Action.

The Examiner gives the reasons for the distinctness between Inventions I and II as (1) that the process as claimed can be used to make other and materially different product, or (2) the product as claimed can be made by another and materially different process (M.P.E.P. 806.05(f)). However, upon reading the process Claims against the product Claims one can readily see that the process Claims are directed to "a method to form an integrated circuit device", and that the product claims are directed to "an integrated circuit device", and that it is necessary to obtain claims in both the process and product claim language. The process claims necessarily use the product and vice versa. The field of search must necessarily cover both the process class/subclass 438/107,109-100,117, and product class/subclass 257/723-726, in addition to other related classes and subclasses, to provide a complete and adequate search. The fields of search for Groups I and II are clearly and necessarily co-extensive. The Examiner's suggestion that "the integrated antenna, heat sink, or EMI shield can be made separately and attached to the chip carrier via adhesive instead of molding" is speculative and has nothing to do with the Claims as presented in this patent application.

Further, it is respectfully suggested that these reasons are insufficient to place the additional cost of second and third patent applications upon the applicants. Therefore, it is respectfully requested that the Examiner withdraw this restriction requirement for these reasons.

Applicant was further required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable, and that currently no claim is generic.

The species stated are:

- a. Claims 1-19 a semiconductor packaging device with antenna, which reads on Claims 1-19, and
- b. Claims 20-41 a semiconductor packaging device with EMI shield, which reads on Claims 20-41, and
- c. Claims 42-61 a semiconductor packaging with heat sink, which reads on Claims 42-61.

Applicant provisionally elects to be examined the species described by the Examiner as Group a., which reads on Claims 1-19. This election is made with traverse of the requirement under 37 C.F.R. 1.143 for the reasons given in the following paragraphs.

The Examiner is respectfully requested to reconsider the Requirement for Election of Species given in the Office Action, because of the increased costs applicant would be forced to bear if the three species are separately examined. Furthermore, the field of search must necessarily cover all species, in addition to other related Classes and subclasses, to provide a complete and adequate search.

Withdrawal of the Restriction Requirement, and allowance of the present Patent Application, is respectfully requested.

It is requested that should there be any problems with this response, please call the undersigned Attorney at (845) 452-5863.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'SBA', with a long horizontal flourish extending to the right.

Stephen B. Ackerman, Reg. No. 37,761